

ESTTA Tracking number: **ESTTA558194**Filing date: **09/06/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | | | |
|---------|--|-------------|----------|
| Name | Giovanni's Pizza, Inc. | | |
| Entity | Corporation | Citizenship | Kentucky |
| Address | 715 Greenup Ave. Ashland, KY 41101 UNITED STATES | | |

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| Attorney information | Adam S. Baldridge, Nicholas L. Vescovo Baker, Donelson, Bearman, Caldwell & Berkowitz, PC 165 Madison Ave., Suite 2000 Memphis, TN 38103 UNITED STATES trademarks@bakerdonelson.com, abaldridge@bakerdonelson.com, nvescovo@bakerdonelson.com Phone: 901-577-2102 |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 85885085 | Publication date | 08/13/2013 |
| Opposition Filing Date | 09/06/2013 | Opposition Period Ends | 09/12/2013 |
| Applicant | Grand Fia, Inc. 579 Grand Concourse Bronx, NY 10451 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 043. First Use: 1974/12/31 First Use In Commerce: 1974/12/31 All goods and services in the class are opposed, namely: Restaurant and catering services |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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Marks Cited by Opposer as Basis for Opposition

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| U.S. Registration No. | 1452339 | Application Date | 08/18/1983 |
| Registration Date | 08/11/1987 | Foreign Priority Date | NONE |
| Word Mark | GIOVANNI'S | | |
| Design Mark | | | |
| Description of Mark | NONE | | |

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|----------------|---|
| Goods/Services | Class 029. First use: First Use: 1969/03/01 First Use In Commerce: 1969/03/01 Meat Class 042. First use: First Use: 1969/03/01 First Use In Commerce: 1969/03/01 Restaurant Services |
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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1452339 | Application Date | 08/18/1983 |
| Registration Date | 08/11/1987 | Foreign Priority Date | NONE |
| Word Mark | GIOVANNI'S | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 029. First use: First Use: 1969/03/01 First Use In Commerce: 1969/03/01 Meat Class 042. First use: First Use: 1969/03/01 First Use In Commerce: 1969/03/01 Restaurant Services | | |

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|-------------|---|
| Attachments | MEMPDOCS- #2429682-v2-Giovanni_GrandFia_Notice_of_Opposition.pdf(99166 bytes) MEMPDOCS- #2429849-v1-Giovanni_s_Grand_Fia_Ex_A_to_Notice_of_Opposition.pdf(17743 bytes) |
|-------------|---|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|---------------------------------------|
| Signature | /Adam S. Baldrige/ |
| Name | Adam S. Baldrige, Nicholas L. Vescovo |
| Date | 09/06/2013 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Trademark Application Serial No.: 85/885,085

Mark: GIOVANNI

Application Filing Date: March 25, 2013

GIOVANNI'S PIZZA, INC.

Opposer,

v.

GRAND FIA, INC.

Applicant.

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Opposition No. _____

Serial No. 85/885,085

NOTICE OF OPPOSITION

Giovanni's Pizza, Inc., a Kentucky corporation having its principal office at 715 Greenup Ave., Ashland, KY 41101 ("Opposer"), asserts that it would be damaged by the registration of GIOVANNI as shown in U.S. Trademark Application Serial No. 85/885,085 (the "Application" or "'085 Application") for the services identified therein and hereby opposes registration of the mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

As grounds for this Opposition, Opposer alleges as follows:

Opposer's Mark

1. Opposer is the owner of a federal trademark registration for "GIOVANNI'S", U.S. Registration No. 1,452,339 for "meat" in International Class 29 and "restaurant services" in

International Class 42¹ (the “‘339 Registration”). The United States Patent and Trademark Office granted the ‘339 Registration on August 11, 1987. The ‘339 Registration is valid and subsisting and remains in full force and effect and is evidence of Opposer’s exclusive right to own and use the mark at issue in connection with the goods and services specified in the registration. A copy of the ‘339 Registration is attached hereto as Exhibit A.

2. The GIOVANNI’S trademark has been used in interstate commerce in connection with the goods and services listed in the ‘339 Registration since at least as early as March 1, 1969, and Opposer has spent significant effort and sums of money in advertising and otherwise promoting its services under the GIOVANNI’S trademark.

3. Opposer’s GIOVANNI’S trademark has obtained incontestable status under Section 15 of the Lanham Act, 15 U.S.C. § 1065.

4. Opposer has locations throughout the United States, including in Kentucky, Virginia, West Virginia, Tennessee, North Carolina, and Ohio, where restaurant services are offered under the GIOVANNI’S trademark.

5. The trade and purchasing public has come to know and recognize Opposer’s GIOVANNI’S trademark as a designation identifying Opposer as the source of restaurant services. Accordingly, Opposer’s GIOVANNI’S trademark has developed and represents valuable goodwill which rightfully belongs exclusively to Opposer.

¹ While the ‘339 Registration lists restaurant services in Class 42, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (“the Nice Agreement”) was amended, effective January 1, 2002, to restructure Class 42 and add three new service classes (Classes 43 through 45). See T.M.E.P. § 1401.09. Class 43 was created to cover “services for providing food and drink.” See T.M.E.P. § 1401.02(a). When the changes were adopted, the USPTO did not require reclassification of existing registrations or applications filed before January 1, 2002. See T.M.E.P. § 1401.09; see also 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 19:56 (4th ed. 2012).

Applicant's Mark

6. To the best of Opposer's knowledge, the name and address of the current owner of the '085 Application is Grand Fia, Inc., a New York corporation with an address of record at 579 Grand Concourse, Bronx, New York 10451.

7. Applicant filed a use-based application for registration of the mark GIOVANNI, Serial No. 85/885,085, for "restaurant and catering services" in International Class 043 on March 25, 2103.

8. According to the '085 Application, Applicant has made no use prior to December 31, 1974 of the GIOVANNI mark with respect to the Class 43 services listed in the Application.

Likelihood of Confusion, Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d)

9. Applicant's mark is essentially identical to Opposer's GIOVANNI'S trademark in appearance and commercial impression, in that it contains the same word "GIOVANNI" and only lacks the apostrophe and letter "S" included with Opposer's trademark. Both marks are directed to restaurant services.

10. Opposer's use of its GIOVANNI'S trademark pre-dates Applicant's alleged first use of and application for registration of the GIOVANNI mark and establishes the priority of Opposer's GIOVANNI'S trademark.

11. Opposer asserts that it will be damaged by the use and registration of the mark GIOVANNI because the Applicant's mark so resembles Opposer's GIOVANNI'S mark previously used in the United States and not abandoned as to be likely, when used on or in connection with those goods and services, to cause confusion, to cause mistake or to deceive.

12. Applicant's GIOVANNI mark is confusingly similar to Opposer's GIOVANNI'S trademark, and Applicant seeks to register the mark for use in connection with identical and closely related services.

13. Accordingly, if the GIOVANNI mark is registered, the registered mark will cast a cloud upon Opposer's registration of the GIOVANNI'S trademark, as well as Opposer's right to use and expand the use of its GIOVANNI'S mark, and the GIOVANNI mark would thus be a source of damage and injury to Opposer.

14. Additionally, if Applicant is granted the registration herein opposed, it would thereby obtain a prima facie exclusive right to the use of the GIOVANNI mark. Such registration would be a source of damage and injury to Opposer.

15. Opposer asserts that Applicant's registration and use of GIOVANNI is without Opposer's permission or authority and is likely to cause confusion, to cause mistake, or to deceive the purchasing public as to the source or origin of Applicant's restaurant services within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d).

WHEREFORE, Opposer prays that, pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), U.S. Trademark Application Serial No. 85/885,085 be denied in its entirety.

Dated: September 6, 2013

Respectfully submitted,

/Adam S. Baldrige/

Adam S. Baldrige (TN Bar No. 23488)

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Attorneys for Opposer, Giovanni's Pizza, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of September, 2013, a copy of the foregoing Notice of Opposition was served upon Applicant's counsel of record, via first-class mail, postage prepaid:

Ronald D. Coleman, Esq.
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New York, New York 10119-0196

/Adam S. Baldrige/

Adam S. Baldrige

EXHIBIT A

Int. Cls.: 29 and 42

Prior U.S. Cls.: 46 and 100

United States Patent and Trademark Office

Reg. No. 1,452,339

Registered Aug. 11, 1987

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

GIOVANNI'S

GIOVANNI'S PIZZA, INC. (KENTUCKY COR-
PORATION)
720 GREENUP AVE.
ASHLAND, KY 41101

FOR: MEAT, IN CLASS 29 (U.S. CL. 46).

FIRST USE 3-1-1969; IN COMMERCE
3-1-1969.

FOR: RESTAURANT SERVICES, IN CLASS
42 (U.S. CL. 100).

FIRST USE 3-1-1969; IN COMMERCE
3-1-1969.

OWNER OF U.S. REG. NO. 1,160,409.

SER. NO. 439,795, FILED 8-18-1983.

SUE CARRUTHERS, EXAMINING ATTORNEY